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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/041,856	01/07/2002	Susan Slaughaupt	1829-4004US1	5418
27123	7590	01/13/2006	EXAMINER	
MORGAN & FINNEGAN, L.L.P.			MYERS, CARLA J	
3 WORLD FINANCIAL CENTER			ART UNIT	
NEW YORK, NY 10281-2101			PAPER NUMBER	

1634

DATE MAILED: 01/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action Before the Filing of an Appeal Brief	Application No. 10/041,856	Applicant(s) SLAUGENHAUPT ET AL.	
	Examiner Carla Myers	Art Unit 1634	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 22 December 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
- b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
- Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
- (a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ They raise the issue of new matter (see NOTE below);
- (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☒ Applicant's reply has overcome the following rejection(s): See Continuation Sheet.
6. ☒ Newly proposed or amended claim(s) 50,61,65 and 76 would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
- The status of the claim(s) is (or will be) as follows:
- Claim(s) allowed: 50.
- Claim(s) objected to: 63 and 65 (as being dependent on a rejected claim).
- Claim(s) rejected: 44-49,51-62,64 and 66-75.
- Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____
13. ☒ Other: Note the attached CRF Problem Report.


 CARLA J. MYERS
 PRIMARY EXAMINER

Continuation of 3. NOTE: the amendment to add claims 77 and 78 raises new issues under 35 USC 102 that would require further search and consideration. In particular, the amendment to add new claim 77 raises new issues because this claim is drawn to subject matter that it is not entitled to the filing date of the priority document. That is, the '080 application does not provide basis for the full length molecule of SEQ ID NO: 1, as is encompassed by the claim. Thereby, the claim is entitled to the filing date of 1/7/02. The cited prior art of Rubin, Anderson and Slaughter (March 2001) teaches nucleic acids consisting of 16 or more nucleotides of SEQ ID NO: 1, wherein the nucleic acids include a cytosine at nucleotide position 33,714 of SEQ ID NO: 1 (corresponding to nucleotide 2390 of Rubin, and position 2397 of Anderson and Slaughter). With respect to newly added claim 78, this claim does not have priority to the '080 priority application because the '080 application does not provide basis for the concept of an oligonucleotide consisting of 16, 17, 18 etc or more nucleotides of SEQ ID NO:2 including nucleotide position 2397. Accordingly, the Rubin, Anderson and Slaughter (March 2001) are prior art to the claimed subject matter. Thereby, claims 77 and 78 would raise new issues under 35 USC 102 .

Continuation of 5. Applicant's reply has overcome the following rejection(s): the obviousness-type double patenting rejection of claims 44-75.

Continuation of 11. does NOT place the application in condition for allowance because: for the reasons of record in view of the non-entry of the after final amendment. Further, it is noted that the objection to the specification under 35 USC 132(a) is maintained in view of the non-entry of the CRF copy of the Sequence Listing. A new CRF copy of the Sequence Listing and a statement that the CRF and paper copies of the Sequence Listing are the same is required.

STIC Biotechnology Systems Branch

CRF Problem Report

The Biotechnology Systems Branch of the Scientific and Technical Information Center (STIC) experienced a problem when processing the following computer readable form (CRF):

Application Serial Number: 10/041,856 B
Filing Date: 01/07/2002
Date Processed by STIC: 01/03/2006

STIC Contact: Mark Spencer: Telephone: 571-272-2510; Fax: 571-273-0221

Nature of Problem:

The CRF (was):

- ☒ (circle one) Damaged or Unreadable (for Unreadable, see attached)
- ☐ Blank (no files on CRF) (see attached)
- ☐ Empty file (filename present, but no bytes in file) (see attached)
- ☐ Virus-infected. Virus name: _____ The STIC will not process the CRF.
- ☐ Not saved in ASCII text
- ☐ Sequence Listing was embedded in the file. According to Sequence Rules, submitted file should **only** be the Sequence Listing.
- ☐ Did not contain a Sequence Listing. (see attached sample)
- ☐ Other: _____

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SEE BELOW FOR ADDRESS:**

<http://www.uspto.gov/web/offices/pac/checker/chkrnote.htm>

Applicants submitting genetic sequence information electronically on diskette or CD-Rom should be aware that there is a possibility that the disk/CD-Rom may have been affected by treatment given to all incoming mail.

Please consider using alternate methods of submission for the disk/CD-Rom or replacement disk/CD-Rom.

Any reply including a sequence listing in electronic form should NOT be sent to the 20231 zip code address for the United States Patent and Trademark Office, and instead should be sent via the following to the indicated addresses:

1. EFS-Bio (<<http://www.uspto.gov/efb/efs/downloads/documents.htm>> , EFS Submission User Manual - ePAVE)
2. U.S. Postal Service: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450
3. Hand Carry, Federal Express, United Parcel Service, or other delivery service (EFFECTIVE 01/14/05):
U.S. Patent and Trademark Office, Mail Stop Sequence, Customer Window, Randolph Building, 401 Dulany Street, Alexandria, VA 22314

Revised 01/24/05

Sample of Submitted file

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0 dir(s)

1,278,464 bytes free

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Read fault error reading drive A
Abort, Retry, Fail?

A:\>DIR

Volume in drive A has no label
Directory of A:\

SECOND~1 TXT 178,863 12-22-05 6:07p second sub seq list.TXT
1 file(s) 178,863 bytes
0 dir(s) 1,278,464 bytes free

A:\>TYPE SECOND~1.TXT

Read fault error reading drive A
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12/28